

### **REMARKS**

#### ***Restriction Requirement and Redating of the Office Action***

In response to a telephonic restriction requirement, Applicants' undersigned representative, in a telephone conversation with the Examiner on September 17, 2003, elected the invention of Group I (claims 4-8 and 17) without traverse.

Applicants' undersigned representative informed the Examiner in a telephone conversation on November 20, 2003 that an Office Action issued for this application was mailed on September 26, 2003 to an incorrect mailing address. The Office Action also improperly set a statutory period for reply of 1 month. The Examiner agreed to redate the Office Action and reset the statutory reply period to 3 months. A corrected Office Action was received soon thereafter.

#### ***Status of the Claims***

Claims 4-8 and 17 have been amended. Non-elected claims 9-15 and 18-19 have been canceled without prejudice and with the understanding that Applicants may choose to pursue them in a divisional application.

Claim 4 has been amended to

- remove the preamble language of "for a silicone oxide containing material";
- limit the N,N-disubstituted (meth) acrylamides of formula 2b to noncyclic derivatives;
- clarify the structural representation of the chemical formulae 1b and 2b by indicating a bond linkage to the COOR<sup>2</sup> and CONR<sup>4</sup>R<sup>5</sup> groups, respectively;
- restate the range of acceptable water vapor permeability in an alternative manner; and
- correct the simple typographical errors in the representation of the letters (a), (b) and (c).

The amendment to claim 4 that limits the N,N-disubstituted (meth) acrylamides to noncyclic derivatives finds support in Applicants' specification at, for example, page 12, lines 1-8.

Claims 5-8 have also been amended to remove the preamble language of "for a silicone oxide containing material."

Claim 6 has been amended to correct the typographical error of "acrylamide" to "acrylate" and to correct the misspelling of the term "isodecyl."

Claim 7 has been amended to limit the exemplary N,N-disubstituted (meth) acrylamides of formula 2b to non-cyclic compounds.

Claim 17 has been amended to correct the typographical error that resulted in an incomplete recitation of the monomer of the pressure-sensitive adhesion sheet of claim 8. The support for the amendment to claim 17 can be found, for example in claim 16 as originally filed and at page 12 of Applicants' specification, lines 20-25.

No new matter has been introduced by any of the amendments.

***I. OBJECTION UNDER 37 CFR 1.75 (c)***

Claim 17 is objected to under 37 CFR § 1.75(c) as being of improper dependent form for failing to further limit the subject matter of a previous claim. The Examiner states that Applicants are required to cancel the claim, amend the claim to place the claim in proper dependent form, or to rewrite the claim in independent form.

In amending claim 17, Applicants have corrected the typographical error that resulted in original claim 17 being incomplete in its recitation of the monomer of the pressure-sensitive adhesion sheet of claim 8. As such, Applicants request that the objection of claim 17 for being in improper dependent form be withdrawn.

***II. REJECTION UNDER 35 U.S.C. § 103(a)***

Claims 4-8 and 17 are rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over JP 06-200225 ("JP '225"). The Examiner states that JP '225 is directed to a pressure sensitive adhesive sheet which is resistant to acid rain and has good adhesion to a new coating material, such as an automotive acrylic coating material. The Examiner further states that the adhesive disclosed by JP '225 comprises an acrylic polymer of 60-93 wt% of an alkyl (meth)acrylate, 2-10 wt% of an unsaturated carboxylic acid, 5-30 wt% of a cyclic (meth)acrylamide and 0-15 wt% of a N-vinyl cyclic amide. According to the Examiner, although JP '225 is silent about the water vapor permeability of the plastic film (Applicants' claims 4, 6-8 and 17) and about the gel percentage of the adhesive acrylic polymer (Applicants' claim 5), these parameters are either inherently disclosed by JP '225 or are an obvious optimization to one skilled in this art.

As amended, independent claim 4 (along with claims 5-8 and 17 dependent therefrom) have been limited to noncyclic (meth) acrylamides. In contrast, JP '225 is restricted to cyclic (meth) acrylamides and does not teach or suggest the use of noncyclic (meth) acrylamides. As such, a

person of ordinary skill in the art would not be motivated, after reading *JP '225*, to employ noncyclic (meth) acrylamides in a preparing the pressure-sensitive adhesive of Applicants' invention with any reasonable expectation of success. Applicants therefore respectfully request that this ground for rejection be withdrawn.

### **III. CONCLUSION**

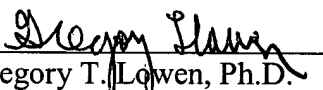
Upon consideration of the foregoing, it will be recognized that Applicants have fully and appropriately responded to all of the Examiner's rejections. The amended claims are fully supported by the specification and do not add new matter. Accordingly, the claims are believed to be in proper form in all respects and a favorable action on the merits is respectfully requested.

**EXCEPT** for issue fees payable under 37 C.F.R. § 1.18, the Director is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or to credit any overpayment to Deposit Account 50-0310. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

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